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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,125	01/19/2001	Jonathan E. Lowthert	42390P10483	9472

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EXAMINER	
RAMAN, USHA	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,125	LOWTHERT ET AL.	
	Examiner	Art Unit	
	Usha Raman	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2-01-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

References

1. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 17, 47-48, 50-52, and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Knepper et al. (US Pre Grant Pub. 2001/0042249).

In regards to claim 1, Knepper discloses an apparatus (101, 603) for receiving media content, advertising and instruction set data from remote servers (107) over links and for providing the data to a presentation device (623) (see figs 1 and 7), comprising:

A link for receiving an instruction set, which indicates the placement and association of advertisement files in media files (note fig. 5, 405), and therefore comprises an info segment port for coupling to a first of the links to receive there over an info segment;

A link for receiving media clips (note fig. 5, 407), and therefore comprises a content port for coupling to a second of the links to receive there over a content item;

A link for receiving an ad port for coupling to a third of the links to receive there over an advertisement (note fig. 5, link receiving ads); and

The user apparatus 101 comprises a client computer running a client side application (see [0031] and claim 80), and therefore comprises a controller coupled to the info segment, content and ad ports, the controller being adapted to provide the content item to the presentation device, until the info segment indicates an ad insertion point (i.e. through ad insert tags) and the controller then

being operative to provide the advertisement to the presentation device (see [0055], [0057], [0059], [0013], [0037], [0038], [0041]).

In regards to claim 17, Knepper discloses that the entertainment and/or advertisement media files may comprise a .pdf file (the computer therefore comprises a .pdf reader). An e-book is typically available as a .pdf file, therefore the system of Knepper comprises an e-book viewer (i.e. the pdf reader).

In regards to claim 47, see claims 1 and 17 above. In further regards to claim 47, and claims 48, 50, 51, 59 and 60, Knepper discloses that the ad entry in the instruction set can specify an ad type, to indicate the types of ads that are appropriate (permitted type) or inappropriate (prohibited type) for playing with the entertainment media, i.e. based on the associations indicated in the instruction set as well as certain criteria at the user end, it is determined if a given ad is suitable to be played, and if not to play an ad that is in compliance with the instruction set and the set criteria (i.e. play an alternative advertisement). Therefore, the apparatus comprises means for determining whether the received ad meets a criterion of the specified ad type (i.e. by determining if a given ad meets the association requirements or not, and therefore indicating if an ad is of a permitted type), and if the ad does not, for retrieving another advertisement (i.e. viewing alternative content). See [0061], [0072], [0081], [0084].

In regards to claim 57, see claim 1 above. In further regards to claim 57, Knepper discloses that the entertainment and/or advertisement media can be

shockwave games. Therefore the system comprises a shockwave video game player.

In regards to claim 58, interruption points are associated with a shockwave game in an instruction set file (via adInsert tags).

4. Claims 1-16, 18, 23-34, 39-45, 52-54 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (US Pat. 6,698,020).

In regards to claim 1, Zigmond discloses an apparatus for receiving data from servers (50) over links (64, 52) and for providing the data to a presentation device (60 58), the apparatus comprising: an info segment port for coupling to a first of the links to receive thereover an info segment (ad selection criteria, see column 11, lines 50-53, lines 66-67, and column 12 lines 1-9)); a content port for coupling to a second of the links (52) to receive thereover a content item (programming content); an ad port for coupling to a third of the links (64) to receive thereover an advertisement (from ad source 62); and a controller (60, a general purpose computer) , coupled to the info segment port, the content port, and the ad port, the controller being adapted to provide the content item to the presentation device until the info segment indicates an ad insertion point (indicated by triggers see column 15, lines 35-37, column 16, lines 34-37, and 40-41), and to then provide the advertisement to the presentation device.

In regards to claim 2, 3 and 4, Zigmond teaches local info segment store (see column 11, lines 30-37), local ad store (86), and local content store (such as video tapes, see column 7, lines 9-12).

In regards to claims 5 and 6, Zigmond discloses that the info segment can be delivered over the same link/channel as the advertisements. See column 12, lines 1-3. Furthermore, the program content, advertisement and info segment can all be received from the content provider using a same physical port (for receiving cable broadcast channels). Furthermore, the transmission medium of the info segment, content and advertisements occur over the same physical link (transmission path can be cable, satellite, etc.)

In regards to claim 7, Zigmond discloses that certain advertisements can be played only with specific programs. The controller therefore has means for comparing content identifier of the advertisement in order to determine if it can be played with the program or not. See column 11, lines 42-47, see column 12, lines 52-56, lines 60-67, column 13, lines 1-6.

In regards to claim 8 and 9, Zigmond discloses determining if a received ad meets a criterion (such as rating) for a specified ad type and if it does not, retrieving an ad that meets the criterion. For example, when indicated by the ad selection criteria, the insertion device prevents certain types of ads (R-Rated) from being played and permitting other types of ads to be played (PG-Rated). Note column 10, lines 58-61 and column 13, lines 48-58.

In regards to claim 10, Zigmond discloses determining if a content is of a type during which received ad can be played or not (for example block all advertisements during paid subscription). See column 14, lines 30-33.

In regards to claim 11, advertisements are downloaded from a content provider using an external link.

In regards to claim 12, when content program is retrieved from local store such as a video tape or local storage, it uses an internal link.

In regards to claim 13, Zigmond discloses that ad insertion device maybe integrated in a television that also includes a display device 58. See column 7, lines 50-52.

In regards to claim 14, Zigmond discloses resuming the play of the content program after the play of the advertisement. See column 17 lines 35-37.

In regards to claim 15, Zigmond discloses that the apparatus comprises means to play a CD ROM or other optical disk storage and therefore comprises a DVD player. See column 6, lines 56-57.

In regards to claims 16, a content program comprises an audio/video component. Furthermore, Zigmond also discloses transmitting a stand-alone audio document (with freeze frame video). See column 9, lines 10-18. The receiving system plays the received audio component and therefore comprises an audio-music player.

In regards to claim 18, see claims 1 and 14.

In regards to claim 23, Zigmond discloses that upon completing the play of the advertisement, the program content resumes play. Furthermore, a program is also associating a plurality of implicit or explicit triggers (i.e. interruption points) with a video program. See column 8, lines 55-65 and figure 2. Therefore, the

content programming resumes play until the next trigger point (interruption point) is encountered.

In regards to claim 24, Zigmond discloses that the first content item is content programming (such as a television show) and the second content item is advertisement. See abstract.

In regards to claim 25, the ad selection criteria requests advertisements from content provider and pre-caches it in ad repository. The insertion ad then selects advertisements to be inserted into content programming from the ad repository. See column 15, lines 24-27 and lines 57-61.

In regards to claim 26, see claim 25. In further regards to second content item meeting a "criterion", Zigmond discloses prefiltering process for selectively storing only advertisements that match a certain criteria determined by the ad selection criteria. See fig. 5 and column 15, lines 17-23.

In regards to claim 27, 28, 41, 42, 43, Zigmond discloses that an ad lock specifier may be provided for services with subscription fees thereby preventing commercials from playing due to the ad lock. In doing so, the system alters the play of the second content (defeating the interruption point, thereby not playing the ad at all). See column 14, lines 30-33.

In regards to claim 29, Zigmond associates ad selection criteria matches the advertisement with program content information in the EPG. Therefore the ad selection criteria contains a program content identifying value for associating

the information in the EPG pertaining to a program to an advertisement. Se column 11 lines 42-46.

In regards to claim 30, Zigmond teaches implicitly associating first content with advertisements (and therefore info segment for correlating advertisements with program on the fly). See column 16, lines 1-5, and lines 20-37.

In regards to claim 31, see claim 1 and 15.

In regards to claim 32, Zigmond discloses retrieving advertisements from an external server (content provider).

In regards to claims 33 and 40, see claim 2.

In regards to claim 34, see claim 14.

In regards to claim 39, see claims 1, 16 and 14.

In regards to claims 44, 45, Zigmond teaches using content ratings to prevent the play of certain types of ads (such as R-Rated) and permitting other types of ad to be played (for example PG-Rated). Therefore an R-Rated advertisement does not meet the criteria for PG-type content and will not be played. See column 10, lines 58-61, column 13, lines 48-58.

In regard to claim 52, see claims 1, 2, 3 4. Furthermore, Zigmond discloses that the local advertisement insertion device can be implemented on a general-purpose computer comprising plurality of memory storage device. See column 6, lines 53-61.

In regards to claim 53, Zigmond discloses altering the interruption (i.e. forgoing the interruption) of a first content based on a rating of an advertisement

or a subscription level of a subscriber. See column 10, liens 58-61, column 13, lines 48-58, and column 14 lines 30-33.

In regards to claim 54, Zigmond teaches that certain ads that are of a prohibited type from being played. See column 10, liens 58-61, column 13, lines 48-58.

In regards to claim 56, Zigmond teaches associating a plurality of implicit or explicit triggers (i.e. interruption points) with a video program. See column 8, lines 55-65.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat 6,698,020) over Knepper et al. (US Pre Grant Pub. 2001/042249).

In regards to claim 19 Zigmond does not disclose transmitting the info segment in response to receiving the content program or playing the program.

Knepper discloses the step of transmitting an info segment ("instruction set" for correlating advertisements with media programs) to the client in response to a user request for a file. The file is therefore sent in response to receiving a requested file. See 0011 and 0014

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Zigmond in view of Knepper in order to download a new info segment containing new rules for correlating advertisements each media content.

In regards to claim 20, Zigmond discloses using triggers (implicit or explicit) that interrupt the play of the first content after a specified time into play. See abstract.

In regards to claim 21, Zigmond discloses timing the insertion of the ads to align with the original time slots in the program feed. Therefore the interruption point indicates an amount of time from a point at which the play of the content begins in order to align the advertisement time slots (an example also show in figure 2A).

7. Claims 49 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US Pre Grant Pub. 2001/042249) in view of Zigmond et al. (US Pat 6,698,020).

In regards to claim 49 and 61, Knepper does not disclose the step of avoiding the play of a commercial advertisement based on whether or not a payment has been made for the entertainment media.

Zigmond teaches the step of determining if an increased subscription fees are paid for a media content and if so, allow the viewer to forgo the advertisements all together. See column 14, lines 0-33.

It would have been obvious to one of ordinary skill in the art to modify the system of Knepper in view of Zigmond's teachings by presenting an entertainment media without advertisements for a user with increased subscription services, thereby allowing the viewer to view the entertainment media (video game or ebook) without any interruptions.

8. Claims 22, 35-38, 46, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Gadkari (US Pre Grant Pub. 2002/0078443).

With regards to claim 22, 35, 38, 46 and 55, Zigmond does not disclose using maximum interrupt specifier during the interruption of program content. Gadkari discloses the use of a trigger suppression (maximum interrupt specifier) in an ad insertion system, when the secondary content being inserted has a longer presentation time than the interval of the original content (the available time window). Note paragraph 57, in page 5. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Zigmond to include a trigger suppression field as taught by Gadkari in order to force the termination of the presentation of an advertisement (i.e. enable premature termination of an advertisement), when it has reached its "allotted", specified amount of presentation time.

In regards to claim 36, Zigmond discloses that an ad lock specifier may be provided for services with subscription fees thereby preventing commercials from playing due to the ad lock. In doing so, the system alters the play of the second

content (defeating the interruption point, thereby not playing the ad at all). See column 14, lines 30-33.

In regards to claim 37, Zigmond teaches using content ratings to prevent the play of certain types of ads (such as R-Rated) and permitting other types of ad to be played (for example PG-Rated). Therefore an R-Rated advertisement does not meet the criteria for PG-type content and will not be played. See column 10, lines 58-61, column 13, lines 48-58.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ebisawa (US Pre. Grant Pub. 2004/0219977) discloses a system for addressing the drawbacks of "stale" advertisements present in a gaming system by downloading, storing and inserting targeted advertisements.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (571) 272-7375. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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